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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/535,457 03/24/00 BAIJ

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EXAMINER

023482 PM82/0927
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ART UNIT

PAPER NUMBER

3635
DATE MAILED:

09/27/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/535,457

Applicant(s)

BAIJ, FRED CHRISTIAN

Examiner

Chi Q Nguyen

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) 31-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Restrictions Two Groupings

1. Restriction to one of the following inventions is required under 35 U.S. 121:

I. Claims 1-30, drawn to a bundle of framing lumber, classified in class 52, subclass 243.

II. Claims 31-64, drawn to method of marking the bundle of framing lumber classified in class 269, subclass 319.

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either of the following can be shown:

(1) that the process as claimed can be used to make other and materially different product or

(2) that the product as claimed can be made by another and materially different process.

For instant case, the apparatus claims could be marked by a method different than that of group II such as providing and using a continuous rollable stud locating tape adhesively secured to the bottom and top plates of a wall installation the providing a series of indicia desirable position for building studs to be installed.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephonic conversation on 9/21/01 a provisional election was made for the apparatus claims only (1-30) with traverse to prosecute the invention.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. As best understood, claims 1-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Liang (US 5,274,973) in view of Thomas (US 4,845,858).

With regards to independent claims 1-30, Liang discloses stud spacer and mounting system comprising a bottom plate 24, a top plate 56, a plurality of studs 22 extending between top and bottom plate, a plurality of stud locator markings 28 spaced along the lengths of lumber 24 (see Figs. 6 and 8)

Liang does not disclose expressly the framing lumber product having each of the plurality of stud locator marking comprising marking material affixed directly to the respective elongate piece of lumber. Thomas teaches a stud locator marking tape could be laid out 22 adhesively accommodates the sheeting 30 thickness and the existing colored indicia portions 22a, 22b, 22c are automatically representative of 16", 24" and 48" evenly through out the stud (see fig. 1, cols. 1-2).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine Liang's invention with stud locator marking tape from Thomas. The motivation for doing so would have been to provide more visibly convenience for building constructors.

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With regards to claims 2-6, 13-16, 24-27, Liang and Thomas disclose the structural elements for stud locator marking except for specific location of the markers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to set a range of the location of markers, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or working ranges involves only routine skill in the art.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Arnold (US 5,165,212), teaches a panel assembly comprising a top, a bottom spaced markings plate, a plurality of studs, and panels.

Any inquiry concerning this communication should be directed to Chi Q. Nguyen whose telephone number is (703) 6-5-1224, Monday-Thursday (7:00-5:00), Fridays off or examiner's supervisor Carl D. Friedman at (703) 308-0839.

CQN 9/21/01


Carl D. Friedman
Supervisory Patent Examiner
Group 3600